

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) HODES 3-10-15-19-13-6
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 25, 2008</u> Signature <u>/Elizabeth Schumacher/</u> Typed or printed name <u>Elizabeth Schumacher</u>	Application Number 10/674,448	Filed September 30, 2003
	First Named Inventor Marc Scott Hodes	
	Art Unit 1797	Examiner Jyoti Nagpaul

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

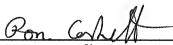
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/95)
- ☒ attorney or agent of record. **47500**
Registration number _____
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature
Ronald J. Corbett

Typed or printed name
972-480-8800

Telephone number
September 25, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Marc S. Hodes, *et al.*

Serial No.: 10/674,448

Filed: September 30, 2003

Title: METHOD AND APPARATUS FOR CONTROLLING THE FLOW
RESISTANCE OF A FLUID ON NANOSTRUCTURED OR
MICROSTRUCTURED SURFACES

Grp./A.U.: 1743

Examiner: Jyoti Nagpaul

Confirmation No.: 4121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being electronically filed
with United States Patent and trademark Office on:
September 25, 2008 (Date)

Elizabeth Schumacher
(Printed or typed name of person signing the certificate)

/Elizabeth Schumacher/
(Signature of the person signing the certificate)

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Appellants have carefully considered this application in connection with the Examiner's Reopening of prosecution and new grounds of rejection mailed June 27, 2008, and respectfully request a Reinstatement of the Appeal and a pre-appeal brief review of this application in view of the following arguments.

ARGUMENTS

Claims 1-6 and 12-13 are currently pending in the application.

I. Rejection of Claims 1, 4 and 6 under 35 U.S.C. §102

The Examiner has rejected Claims 1, 4 and 6 under 35 U.S.C. §102(b) as being anticipated by U.S. 6,603,444 to Kawanami et al. ("Kawanami").

The Appellants submit that the Examiner has not established grounds for Kawanami to teach each and every element of Claim 1.

Claim 1 among other things recites, "means for changing the pressure of at least a first fluid disposed within said plurality of closed cells in order to cause a selected liquid to change the degree of penetration of said feature pattern."

The Examiner acknowledges that Kawanami does not explicitly teach the above-recited elements of Claim 1. The Examiner, however, then asserts that a light/lamp or heat given off by the light is inherently changing the temperature and pressure of a fluid in closed cells and thus causing the liquid to move.

The Appellants respectfully disagree that the Examiner has established that Kawanami discloses a light that changes the temperature of Kawanami's fluid sufficiently to cause a liquid to change its degree of penetration into closed cells. The Appellants present two reasons for their disagreement:

1) The Examiner does not cite any portions of Kawanami that support the notion that a light or lamp actually causes temperature or pressure changes in Kawanami's first liquid 307 or electrolyte solution 308 (Kawanami, FIG. 3), and that these asserted changes actually cause Kawanami's solution 308 to change the degree of penetration into closed cell.

To the contrary, there is at least some evidence that Kawanami takes steps to avoid such temperature induced changes to his display device. For example, Kawanami keeps his lamp 401 remotely located from the display element 405 and even points it away from the element 405 and towards a reflector 402 (see Kawanami, FIG. 4A).

Therefore the Examiner's assertion appears to be a conclusory statement with no rational underpinning to support the legal conclusion of obviousness.

2) Kawanami's first liquid 307 and electrolyte solution 308 appear to both be located in sealed chambers. For example, FIG. 3A-3C of Kawanami depicts the liquid 307 and solution 308 in chambers bounded on all sides by substrate 304, and insulators 306a and 306b. Therefore, it is not clear how the degree of penetration of, for example, the electrolyte 308 into these chambers could change, even if Kawanami's light or lamp could induce changes in the temperature or pressure of the liquid 307 and solution 308.

Therefore, the Appellants respectfully request the Examiner to withdraw the §102 rejection with respect to Claim 1 and its dependent claims.

II. Rejection of Claims 2-4 and 12-13 under 35 U.S.C. §103

The Examiner has rejected Claims 2-3 and 12-13 as under 35 U.S.C. §103(a) as being unpatentable over Kawanami. The Examiner also appears to base the rejection of at least some of these claims further in view of "Humphries" (See Examiner's Detailed Action section 6, page 5). The Examiner, however, does not specifically identify the "Humphries" reference by citation. For the purposes of the present arguments, the Appellants have assumed that the Examiner is referring to EP 0290125 A2 to Humphries. If this is interpretation incorrect, then clarification is requested.

The Appellants respectfully disagree because, for the reasons presented in Section I, Kawanami does not teach or suggest all of the elements of Claim 1, which Claims 2-4 and 12-13 are dependent on, and, the Examiner has not shown how "Humphries" cures the deficient teachings or suggestions of Kawanami.

In view of the foregoing remarks, the cited references as applied by the Examiner do not establish a *prima facie* case of obviousness to support the Examiner's rejection of the above claim under 35 U.S.C. §103(a). The Appellants therefore respectfully request the Examiner withdraw the rejection.

III. Conclusion

In view of the foregoing arguments, the Appellants see all of the Claims currently pending in this application to be in condition for allowance and respectfully request the Examiner to withdraw these rejections, and issue a timely Notice of Allowance for these claims.

The Appellants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read "Ron Corbett", with a stylized flourish at the end.

Ronald J. Corbett
Registration No. 47,500

Dated: September 25, 2008
P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800